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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,846	08/07/2001	Yuichiro Itakura	880-24-026	2166

27934 7590 07/19/2002

NETZERO INC.
2555 TOWNSGATE RD.
WESTLAKE VILLAGE, CA 91361

EXAMINER

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 07/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/923,846

Applicant(s)
Itakura et al

Examiner
Andrew J. Fischer

Art Unit
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47-71 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 47-71 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 47-55, drawn to a method of accumulating and spending, classified in class 707, subclass 9.
 - II. Claims 56-63, drawn to a method of making an online purchase, classified in class 705, subclass 26.
 - III. Claims 64-71, drawn to a system, classified in class 707, subclass 3.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as an online tracking method which rewards users. See MPEP § 806.05(d).
3. Because these inventions are distinct for the reasons given above, because the search required for Group I is not required for Group II, and because the inventions have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. Inventions I and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice

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another and materially different process. (MPEP § 806.05(e)). In this case, the process can be practiced by a materially different invention—one that does not include the structural equivalents of the means for receiving an order.

5. Because these inventions are distinct for the reasons given above, because the search required for Group I is not required for Group III, and because the inventions have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. Inventions II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the process can be practiced by a materially different invention—one that does not include the structural equivalents of the means for receiving an order.

7. Because these inventions are distinct for the reasons given above, because the search required for Group II is not required for Group III, and because the inventions have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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Election of Species

8. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species A

- Species A1: Represented by Figure 1;
- Species A2: Represented by Figure 35;
- Species A3: Represented by Figure 36; and
- Species A4: Represented by Figure 37.

Species B

- Species B1: Represented by Figure 19; and
- Species B2: Represented by Figure 26.

Species C

- Species C1: Represented by Figure 27;
- Species C2: Represented by Figure 28; and
- Species C2: Represented by Figure 31.

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9. In addition to the chosen Invention (Inventions I, II, or III above), Applicant is also required under 35 U.S.C. 121 to elect a single disclosed species from each group (e.g. Applicants may elect A1, B2, and C3) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. The elected species must at least be capable of being used together with the chosen Invention. Currently, no claims are generic.

10. Applicants are advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added in response to this Office Action or in any future amendment. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

11. Upon the allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, Applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

12. Should Applicants traverse on the ground that the species are not patentably distinct, Applicants should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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13. A telephone call to Steven C. Sereboff on July 17, 2002 to request an oral election to the above restriction requirement was attempted, but did not result in an election being made. The phone number listed on the "Fee Transmittal Form for FY 2001" was inoperable. Additionally, the attorneys listed in the declaration appear to be different from the attorneys of record based upon the envelope and submitted documents. Furthermore, because there is both a restriction and an election of species present in this case, the application is "complex." See MPEP §812.01.

14. Applicants are advised that the reply to this requirement to be complete must include a chosen invention *and* elections of the species to be examined even though the requirement be traversed (37 CFR 1.143).

15. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

16. All MPEP sections cited within are from the Manual of Patent Examining Procedure (MPEP) Eighth Edition, August 2001 unless expressly noted otherwise.


17. The art unit and technology center for this application has changed. The new art unit is 3627 in technology center 3600. So that papers may be properly matched, please indicated the new art unit on any paper submitted with this application.

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18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew J. Fischer whose telephone number is (703) 305-0292.

 7/18/02

ROBERT P. OLSZEWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600


ANDREW J. FISCHER
PATENT EXAMINER
7/17/02

AJF
July 17, 2002